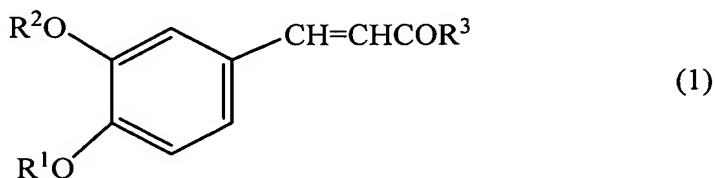


REMARKS

Claims 4, 5, 7, 8, and 11-19 are pending in the present application.

The rejection of Claims 4, 5, 7, 8, 11-19 under 35 U.S.C. 103(a) over Cheng et al (XP-002219274) is respectfully traversed.

The presently claimed invention provides, *inter alia*, a method for treating hypertension, which comprises administering to a patient in need thereof an effective amount of a composition comprising a compound of formula (1):



wherein, R^1 and R^2 are the same or different and each independently represents a hydrogen atom, an alkyl group, an alkenyl group, a cycloalkyl group, a cycloalkenyl group, an alkoxyalkyl group, an aryl group, an alkylaryl group, an aralkyl group or an acyl group, R^3 represents a hydroxyl group, or an amide bond residue, or a pharmaceutically acceptable salt thereof, and wherein said compound of formula (1) is not ferulic acid (see Claim 4).

In the outstanding Office Action, the Examiner has rejected the presently claimed invention over Cheng et al. In making this rejection, the Examiner asserts that Cheng et al “teach treating hypertension with the administration of chlorogenic acid and other caffeoylquinic acids, namely methyl chlorogenate, which are embraced by the compounds of formula (1).” However, this assertion is without merit as Claim 4 was amended on March 14, 2005, to remove “an ester bond residue” from R^3 . As such, Cheng et al no longer disclose any compounds within the scope of formula (1).

The Examiner apparently attempts to overcome this deficiency in the disclosure of Cheng et al by asserting “the skilled artisan would have been motivated to determine and select pharmaceutically acceptable acyl, ester, and amide moieties and derivatives with the known chlorogenic compounds of Cheng et al.” Although not stated in the actual rejection over Cheng et al on page 4 of the Office Action, the apparent basis for this assertion can be found on page 2 of the Office Action where the Examiner cites Solomons’ Organic Chemistry, 2nd Edition, and states “it is well within the purview of the skilled artisan to derivatize the carboxylic acid moiety with amino compounds to easily generate amide bond residues.” Even if the skilled artisan were to possess the general ability to make such a derivatization the question that should be asked is whether the prior art (*i.e.*, Cheng et al) discloses or suggests the same and whether such a change would be expected to produce the claimed anti-hypertensive effect.

It is well settled that whether the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness (MPEP §2143.01). To establish *prima facie* obviousness there must also be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (MPEP §2143.01). Applicants submit that the Abstract of Cheng et al fails to provide such a disclosure or suggestion and that Solomons’ only represents the general state of the art, but does not suggest any modification to chlorogenic acids. Therefore, in view of the absence of some specific suggestion or motivation in the cited art to derivitize the compounds of Cheng et al to arrive at the claimed class of compounds, the outstanding rejection is improper and should be withdrawn.

In view of the foregoing, Applicants request withdrawal of this ground of rejection.

Finally, Applicants respectfully request that the *provisional* obviousness-type double patenting rejections over U.S. 09/944,079, U.S. 10/192,075, and U.S. 10/626,708, as well as the obviousness double patenting rejection over U.S. 6,458,392, be held in abeyance until an indication of allowable subject matter in the present application. If necessary, a terminal disclaimer may be filed at that time. Until such a time, Applicants make no statement with respect to the propriety of this ground of rejection. However, Applicants remind the Examiner that MPEP §804 states:

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

Accordingly, if the present amendment places the elected claims in condition for allowance, Applicants note that the provisional obviousness-type double patenting rejection over U.S. 09/944,079, U.S. 10/192,075, and U.S. 10/626,708 should be withdrawn if these applications are not in condition for allowance.

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

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